



27 JUN 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

LYON & LYON LLP
4225 EXECUTIVE SQ. STG 800
LA JOLLA, CA 92037-9150

In re Application of :
ROWLEY :
Application No.: 10/030,318 :
PCT No.: PCT/US00/10415 :
Int. Filing Date: 18 April 2000 : DECISION
Priority Date: 22 April 1999 :
Attorney Docket No.: 268/207 US :
For: HIGH SECURITY BIOMETRIC :
AUTHENTICATION USING A PUBLIC :
KEY/PRIVATE KEY ENCRYPTION PAIRS :

This decision is in response to applicant's "PETITION TO ACCORD EARLIER FILING DATE UNDER 37 CFR 1.10(e)" filed 01 March 2002.

BACKGROUND

On 18 April 2000, applicant filed international application PCT/US00/10415, which claimed a priority date of 22 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 02 November 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 November 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 October 2001.

On 19 October 2001, applicant filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) of \$130 for filing the oath or declaration later than thirty months from the priority date. These application papers were assigned application number 10/030,318.

On 01 March 2002, applicant filed the instant "PETITION TO ACCORD EARLIER FILING DATE UNDER 37 CFR 1.10(e)" requesting that the copy of the application papers accompanying the petition and purportedly filed by Express Mail on 19 October 2001 be accepted as having been received on 19 October 2001 and processed. This submission was treated as a new application and assigned application number 10/070,573. The petition was also accompanied by, *inter alia*, a purported preliminary amendment, an Information Disclosure Statement, and copies of 35 references.

On 12 March 2002, in application number 10/030,318, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor was required. The Notification set a two month extendable time period.

DISCUSSION

Upon review of both application files, it is concluded that the papers filed 01 March 2002 were erroneously processed as a purported new application and assigned application No. 10/070,573. Accordingly, the papers filed on 01 March 2002 (including the IDS and reference copies) have been placed in application number 10/030,318. Purported application 10/070,573 is no longer an active application number and should not be used in any future correspondence regarding this application. The petition under 37 CFR 1.10(e) filed 01 March 2002 is moot since the papers originally submitted on 19 October 2001 have been received.

The preliminary amendment filed 01 March 2002 has not been entered. The application was filed under 35 U.S.C. 371, as evidenced by the Transmittal Letter filed 19 October 2001 which states that the submission is a "filing under 35 U.S.C. 371". Such an application is an entry into the national stage of an international application. The international application includes the international application as filed, amendments to the claims made under Article 19 of the PCT, and amendments made under Article 34 of the PCT. Thus, the drawings are already part of the national stage application. Also, the copy of the specification which was submitted by applicant, and which includes language referring to priority claims on page 1 which does not appear in the international application, will not be entered. Finally, it is noted that the amendments made under Article 34 during international preliminary examination have been entered (i.e., the Annexes to the International Preliminary Examination Report have been entered). Thus, it is the international application as amended under Article 34 which will be forwarded for examination. Any amendments applicant wishes to make to the application during the national stage must be made by amendment under 37 CFR 1.121 or by submitting a substitute specification under 37 CFR 1.125.

Applicant should use application number **10/030,318** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/US00/10415.

CONCLUSION

The petition under 37 CFR 1.10(e) filed 01 March 2002 is **DISMISSED** as **MOOT** for the reasons set forth above.

The papers filed on 01 March 2002 have been placed in application number 10/030,318.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the

letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including awaiting response to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 12 March 2002.



Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459